

(hollow) particles and the diameter of the smaller particles exhibit overlap but do not coincide with the corresponding ranges claimed by applicants. Further, Hoshino does not disclose a waterborne pigmented paper or paperboard coating composition which is a "high carbonate" composition, as it is termed in the art, namely, a composition in which the pigment includes 50% to 100% calcium carbonate, by weight based on pigment weight. Since Hoshino does not disclose this element of applicants' claim 1, Hoshino fails to disclose each and every element of applicants' claim. Applicants therefore, respectfully assert that their claim 1 or new claim 3 is not anticipated by Hoshino under 35 USC 102(b) and request the examiner to withdraw that rejection.

35 USC 103(a) REJECTION OF CLAIM 1 OVER HOSHINO

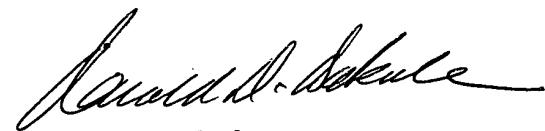
The examiner has rejected claim 1 under 35 USC 103(a) as obvious over Hoshino because Hoshino discloses a mixture of inorganic pigment such as CaCO<sub>3</sub> and hollow emulsion polymer particles having a bimodal size distribution. As the examiner points out, Hoshino's disclosed ranges of the amount of polymer particles relative to pigment, the diameter of the larger (hollow) particles and the diameter of the smaller particles exhibit overlap but do not coincide with the corresponding ranges claimed by applicants. Further, Hoshino does not disclose, teach, or suggest a waterborne pigmented paper or paperboard coating composition which is a high carbonate composition, as it is termed in the art, namely, a composition in which the pigment includes 50% to 100% calcium carbonate, by weight based on pigment weight, as claimed by applicants. Applicants respectfully submit that the examiner has not met his burden in establishing a *prima facie* case of obviousness because he has not pointed to any disclosure within Hoshino which would motivate one to form applicants' composition.

In fact Hoshino's examples provide no expectation of increased gloss or brightness through the use of his bimodal system in his relatively low

carbonate compositions. In Table 2 (Hoshino's [0031] on page 12 of the translation provided) Hoshino's Comparative Example 1 (a unimodal polymer) exhibits substantially the same white paper gloss and print gloss as each of the Working Examples 1-5. And Hoshino's Comparative Example 2 (a unimodal polymer) exhibits substantially the same white paper gloss and print gloss as Working Example 5, to which it is closely related. The same trends are found for Hoshino's degree of whiteness. The fair teaching of Hoshino, applicants submit, is that his invention offers no indication of enhanced gloss or whiteness, thereby providing no motivation *per se* to modify his composition or his pigmentation to afford a gloss or brightness increase. Applicants invention (Specification, page 2, lines 9-16), on the other hand, is particularly directed to the provision of high carbonate coating compositions having higher sheet gloss as well as other advantages including brightness. Applicants respectfully submit that Hoshino, taken as a whole, does not teach or suggest their invention and that their claim 1 or new claim 3, therefore, is not obvious under 35 USC 103(a) over Hoshino.. Applicants urge the examiner to withdraw this rejection.

Applicants respectfully request the examiner to pass their claims 1 and 3 to allowance at this time. Applicants' agent is available in order to expedite the allowance of this case at 215-641-7822 or by FAX at 215-641-7027.

Respectfully Submitted,



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Date: October 8, 2002



### CERTIFICATE OF MAILING

I hereby certify that the following correspondence is being deposited as first class mail with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, DC, 20231 on the date indicated next to my signature below.

Amendment

DATE: Oct. 9, 2002 SIGNATURE: Donald D. Sakale

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